

**PATENT**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

INVENTOR(S) : Christine Miyachi  
TITLE : PARTIAL PRINT PROVIDER  
APPLICATION NO. : 09/726,233  
FILED : November 29, 2000  
CONFIRMATION NO. : 9612  
EXAMINER : WORKU, NEGUSSIE  
ART UNIT : 2625  
LAST OFFICE ACTION : January 24, 2007  
ATTORNEY DOCKET NO. : A0600-US-NP  
XERZ 2 00374D

**APPEAL BRIEF UNDER 37 C.F.R. §41.37**

Mail Stop Appeal Brief-Patents  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

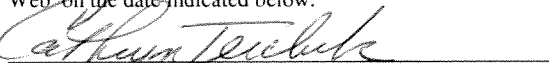
This Appeal Brief is in furtherance of the Notice of Appeal mailed to the U.S. Patent and Trademark Office on March 9, 2007.

The fees required under 37 C.F.R. §41.20(b)(2) and any required petition for extension of time for filing this brief and fees therefor, are dealt with in the accompanying Transmittal of Appeal Brief.

Appellant files herewith an Appeal Brief in connection with the above-identified application wherein claims 1-7 were finally rejected in the Final Office Action of January 24, 2007.

**CERTIFICATE OF ELECTRONIC TRANSMISSION**

I hereby certify that this paper and/or fee is being transmitted to the USPTO by electronic transmission via EFS-Web on the date indicated below.

  
Cathryn Terchek

Date:   
May 19 2007

**I. REAL PARTY IN INTEREST (37 C.F.R. §41.37(c)(1)(i))**

The real parties in interest in this appeal are the inventors named in the caption of this brief (Christine Miyachi, Hang Zhang and Daniel Romano) and the assignee of their interests, Xerox Corporation.

**II. RELATED APPEALS AND INTERFERENCES (37 C.F.R. §41.37(c)(1)(ii))**

Currently, it is believed that there are no other appeals or interferences in process or pending before the U.S. Patent and Trademark Office which the present application bases its priority from, or any cases which base their priority upon the present application, that will directly affect, or will be directly affected by, or will have a bearing on the Board's decision in this appeal.

**III. STATUS OF CLAIMS (37 C.F.R. §41.37(c)(1)(iii))**

The status of the claims set forth after the final Office Action mailed January 24, 2007 was, and is, as follows:

Allowed:	none
Rejected:	1-7

The present appeal is directed specifically to claims 1-7.

**IV. STATUS OF THE AMENDMENT (37 C.F.R. §41.37(c)(1)(iv))**

No amendments have been made that have not been entered by the Examiner.

**V. SUMMARY OF THE CLAIMED SUBJECT MATTER (37 C.F.R. §41.37(c)(1)(v))**

Present claim 1 is the only independent claim pending in the application.

Claim 1 is directed to a partial print provider (page 9, line 21) that permits a first print spooler associated with a network print server to interface with a second print spooler associated with the network print server (page 9, lines 21-24) for further processing of a print job submitted to the network print server from a network print client (page 6, lines 15-16). Figure 3 shows the integration of the partial print provider 70 into the network structure as a relay between the commercial spooler 22 and a proprietary spooler 72.

**VI. GROUND OF REJECTION TO BE REVIEWED ON APPEAL (37 C.F.R.**

**§41.37(c)(1)(vi))**

In the final Office Action, the Examiner maintained his rejection of claims 1-7 under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 5,995,723 to Sperry ("Sperry").

**VII. ARGUMENTS (37 C.F.R. §41.37(c)(1)(vii))**

**A. The Rejection of claim 1**

The Examiner rejected all pending claims under §102 as anticipated by Sperry.

The present claims recite a print provider that allows the interface of a first (usually commercial) print server print spooler with a second (typically proprietary) print server print spooler. Both print spoolers are located on and associated with the print server. This is shown in Figure 3 of the present application with the NT spooler 22 and the proprietary spooler 72. A third print spooler (14 in figure 1) is still located on and associated with the individual workstations. This workstation print spooler sends the print job over the network to the print server, which contains the first and second print spoolers and the print provider that allows interaction between these two print server spoolers.

The Examiner states that Sperry discloses “a partial print provider (processing system 10 of Figure 1, adapted to incorporate plurality of printers, col. 7, lines 1-10) that permits a first print spooler (print spooler 44 of Fig. 2) associated with a network print server (print provider 38 of fig. 2) to interface with a second print spooler (one or more spoolers can be provided, col. 8, 1-5)...associated with the network print server.” (final Office Action, page 2-3). The Examiner continues by stating that “as the reference teaches in col. 7, line 65 through col. 8, lines 1-5, there is a suggestion that more than one spoolers can be implemented in the system.” (Final Office Action, page 5).

Applicants disagree with this rejection for several reasons. First, what the Examiner terms a “partial print provider” in Sperry is in fact the entire network document processing system 10, including a plurality of printers, 12-1, 12-2, etc. (See col. 7, lines 1-35). This processing system is not, and in no way correlates to, the partial print provider, as described and claimed in the present application. Appellants are somewhat at a loss as to how the Examiner can equate the entire document processing system of Sperry with the partial print provider as claimed. Sperry simply does not teach a partial print provider that allows a first print spooler to interface with a second print spooler.



Second, the “one or more spoolers” referenced by the Examiner appear to each INDIVIDUALLY be associated with the “one or more print provider 38” (see col. 7, line 53). That is, there can be one or more print providers in the system in communication with the print request router, as detailed where it states “the print provider set typically includes multiple instances of print providers to accommodate for the various types of printers or print-related devices on the network” (col. 7, lines 54-57). However, only a single print spooler appears to be associated with each print provider, as shown in Fig. 2. This interpretation is further supported in Sperry where it states that “It should be appreciated that a tight ‘coupling’ exists between the Print Assistant 42 and one or more instances of the Print Providers 38 so that information (e.g. commands) can flow freely between the Print Assistant and one or or more spoolers” (col. 7, line 64 – col. 8, line 1). Appellants would like to draw the Board’s attention to the use of the plural for both the print providers and spoolers. Appellants submit that there is no indication that multiple print spoolers are associated with any one print provider, as the Examiner suggests.

Furthermore, and even assuming that Sperry does teach multiple spoolers associated with each Print Provider, there is no disclosure or indication that such spoolers interface with each other. Rather, it appears that print commands are directed from the spoolers to the print provider to the print assistant in Sperry. There is simply no indication of any communication between the multiple print spoolers of Sperry, as recited by the present claims.

Thus, Sperry stands in contrast with the present invention, wherein the workstation print spooler sends the print job over the network to the print server, which contains the first and second print spoolers and the print provider that allows interaction between these two print server spoolers. For all these reasons, Sperry fails to anticipate the present claims.

## **B. The Rejection of Claim 5 and 6**

With respect to these claims, Appellants reiterate all of their comments above. In addition, Appellants submit that Sperry further fails to disclose or suggest wherein all print jobs received by the second spooler are forwarded to the first spooler for further processing or wherein the partial print provider can be modified to establish an interface between the first print spooler and any second spooler.

In support of his rejection of these claims, the Examiner makes blanket statements with citations to sections in Sperry that do not support his contentions (see generally 1<sup>st</sup> and 2<sup>nd</sup> paragraphs on page 5 of the final office action). For example, in rejecting claim 5, the Examiner states "Sperry teaches a partial print provider...wherein all print jobs received by the second spooler (one or more spooler, col. 8, lines 1-5) is forwarded to the first spooler (44 of fig. 2) for further processing."

If one looks at col. 8, lines 1-5 of Sperry, however, there is no discussion of forwarding print jobs from a first spooler to a second spooler. In fact, this section only mentions the existence of one or more spoolers, with no discussion of any interaction or forwarding between them.

Similarly, with respect to claim 6, the Examiner makes unsubstantiated statements that the partial print provider of Sperry can be modified to establish an interface between print spoolers. Again, no substantiation of this assertion is made and the citations to sections of Sperry in no way support his statements.

Thus, Appellants urge the Board to overturn these rejections as well.

### **C. The Examiner's Statement Regarding Applicant's Arguments**

In the final Office Action, the Examiner makes the dubious assertion that "Applicant's arguments do not comply with 37 C.F.R. §1.111(c) because they do not clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made." (final Office Action, page 5). Appellants are confused by this statement. Appellants have at all times during the course of prosecution of this application pointed out the deficiencies of the cited art with respect to the recited elements of the pending claims and how these references do not disclose such elements. Appellants submit that by pointing out the differences between the cited art and the present claims and the fact that the references fail to disclose or suggest the claimed invention, Appellants are, a priori, "pointing out the patentable novelty" of the claimed invention.

**CONCLUSION**

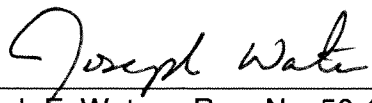
In view of the above, Appellant respectfully submits that claims 1-7 are not anticipated or rendered obvious by the cited art.

Accordingly, it is respectfully requested that the Examiner's rejections be reversed.

Respectfully submitted,

FAY SHARPE LLP

Dated: May 17, 2007

  
\_\_\_\_\_  
Joseph E. Waters, Reg. No. 50,427  
1100 Superior Ave., 7<sup>th</sup> Floor  
Cleveland, Ohio 44114  
(216) 861-5582

**VIII. APPENDIX OF CLAIMS (37 C.F.R. §41.37(c)(1)(viii))**

1. A partial print provider that permits a first print spooler associated with a network print server to interface with a second print spooler associated with the network print server for further processing of a print job submitted to the network print server from a network print client.

2. A partial print provider according to claim 1 wherein the network print server is operating Windows NT software and the second print spooler is a Windows NT print spooler.

3. A partial print provider according to claim 2 wherein the interface between the NT print spooler and the first spooler permits the first spooler to leverage off on Microsoft's print services, protocols and network technologies.

4. A partial print provider according to claim 1 wherein the partial print provider is a dynamically linked library file.

5. A partial print provider according to claim 1 wherein all print jobs received by the second spooler are forwarded to the first spooler for further processing.

6. A partial print provider according to claim 1 wherein the partial print provider can be modified to establish an interface between the first print spooler and any second spooler.

7. A partial print provider according to claim 1 wherein the network print server is configured to be used with a xerographic print device.

**IX. EVIDENCE APPENDIX (37 C.F.R. §41.37(c)(1)(ix))**

None.

**X. RELATED PROCEEDINGS APPENDIX (37 C.F.R. §41.37(c)(1)(x))**

None.